

Customer No. 24498  
Attorney Docket PU030124  
Office Action Date: August 2, 2010

**Remarks/Arguments**

Claims 1-21 are pending in this application. No amendments have been made to the claims in this response.

**Re: Rejection of Claims 1, 7-9, 15 and 16 under 35 U.S.C. §103(a)**

Claims 1, 7-9, 15, and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,926,789 issued to Barbara (hereinafter, "Barbara") in view of U.S. Patent No. 6,987,221 issued to Platt (hereinafter, "Platt"). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants submit that the proposed combination of references fails to produce the claimed invention.

Barbara pertains to an audio-based user interface that allows a user to manually search a directory of audio web pages (see col. 5, lines 31 – 32 "Therefore, according to the present invention, a method is provided for facilitating searching through directory pages"). The audio user interface prompts a user for selections to menu choices. The menu choices are presented in an audible manner. The user responds either by an audible response, such as saying STOP, or by depressing a key stroke that represents STOP.

Each audio web page can have hyperaudio links, where each hyperaudio link links one audio web page with another audio web page. The audio web page can contain audio information in addition to the hyperaudio links. The user manually traverses these audio web pages, by selecting a sequence of hyperaudio links, until the user finds the audio web page of interest.

However, Barbara does not recite the user-selected set of digital audio data files recited in the claimed invention and the steps related thereto.

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Claim 1 recites:

*A method of compiling a playlist of digital audio data files using a digital audio data player, the method comprising the steps of:*

*enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player;*

***automatically playing sequentially an audio clip from each one of the user-selected set of digital audio data files via an audio output device associated with the digital audio data player;***

*detecting whether a user input is received via the user input device while each one of the audio clips is being played; and*

***including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played.***  
(emphasis added).

The Examiner contends that the "automatically sequentially playing" step is taught in Barbara (col. 3, lines 34 - 35, col. 4, lines 63-65 and figures 3 and 5). Applicants respectfully disagree.

The cited section at col. 3, lines 34 - 35 is part of a search of an audio web directory. The user is engaged in responding to voice-driven menu selections. Each selection takes the user to a different audio web page. The audio web page at the cited section is playing a sample of baroque music and a sample of rock music. However, the user in the cited section did not choose these particular audio tracks. In fact, these tracks were pre-programmed onto an audio web page and are played to everyone that accesses that audio web page. It would appear that the Examiner has misapplied the concept accessing of an audio web page with accessing an audio track. The audio web pages of Barbara are not audio tracks. They are web pages that playback a sample of audio. Clearly, the cited section in Barbara differs from automatically sequentially

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playing an audio clip from each one of the user-selected set of digital audio data files because the user does not select the set of audio data files at all.

The cited section at col. 4, lines 62 – 65, states that “[e]ach hyperaudio link is associated with a portion of the audio track of an audio page, in the same manner that a hypertext link in the WWW is associated with a highlighted portion of the text on a page.” However, this does not mean that the audio track is selected by the user when the user clicks on the hyperaudio link. The cited section simply means that the hyperaudio link is associated with an audio track. This differs from automatically sequentially playing an audio clip from each one of the user-selected set of digital audio data files.

The Examiner contends that the “including identifying data” step is found in Barbara at col. 6, lines 53-60 and col. 9, lines 15-25. Applicants respectfully disagree. The cited section at col. 6, lines 53-60 recites that the user can bookmark the audio web page of interest. However, this cited section does not recite that the audio web page is bookmarked while an audio track is playing. It merely states that after the user has manually searched through a number of audio web pages and found an audio web page of interest, the user can bookmark the audio web page for future reference. This cited section differs from “including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played” in particular since the identification date of a web page does not correspond to identification data for the digital audio file.

Therefore, even assuming that the references are combined as suggested by the examiner, the combined arrangement still fails to produce the claimed invention.

The Examiner contends that “[i]t would have been obvious to one skilled in the art at the time of the invention to operate an interface such as that taught or suggested by Platt within the Bar system and method. The average skilled practitioner would have been motivated to utilize a known method at the interface of Platt to improve a similar

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*system for browsing media as taught or suggested by Bar. The average skilled practitioner would have expected such a combination to yield predictable results."*

Applicants respectfully disagree.

Applicants submit that one of ordinary skill in the art would have not have been motivated to modify Platt using the cited teachings of Barbara since the express teachings of Platt teach away from such a modification. In particular, one of Platt's main objectives is to provide a technique which:

"...reduces effort and time required by a user to generate a playlist...[so that] the user is not required to manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist." (emphasis added; see column 2, lines 30 – 36 of Platt).

Barbara requires the user to manually search through search results using voice-activated choices which is precisely what Platt teaches away from. The use of the teachings of Barbara in Platt would defeat the objective of Platt. Accordingly, there would be no motivation to modify Platt in a manner that would require additional user time and effort.

The lack of motivation to combine Platt and Barbara is further supported by the fact that Barbara does not address the problem of how to create a playlist using a digital audio data player, as claimed. Barbara is directed towards searching a directory of audio web pages using a voice prompted user interface. Accordingly, one of ordinary skill in the art, when faced with the problem of how to create a playlist using a digital audio data player, would not be motivated to examine art, such as Barbara which is directed towards solving a completely different problem.

Accordingly, claim 1 and its dependent claims are patentably distinguishable over Barbara and Platt. The remaining independent claims, and the claims that depend on them, recite the above-referenced features and are believed to be patentably

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distinguishable over Barbara and Platt for the same reasons as discussed with respect to claim 1.

**Re: Rejection of Claims 2-5, 10-13, 17-20 under 35 U.S.C. §103(a)**

Claims 2-5, 10-13, 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barbara in view of Platt as applied to claims 1, 8, 15 above and further in view of Heo (US Patent 7,046,588). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully traverse this rejection since Heo is unable to remedy the deficiencies of Platt, Kudou, and Novelli explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

**Re: Rejection of Claims 6, 14, 21 rejected under 35 U.S.C. §103(a)**

Claims 6, 14, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barbara in view of Platt as applied to claims 1, 8, 15 above and further in view of Novelli (US PGPub 2003/0144918), (hereinafter, "Novelli").

Applicants respectfully traverse this rejection since Novelli is unable to remedy the deficiencies of Barbara and Platt explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

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### Conclusion

In view of the foregoing remarks/arguments and accompanying amendments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled.

It is believed that there are no additional fees due with regard to the filing of this response. However if an additional fee is due, please charge the fee, or credit any overpayment, to Deposit Account No. 07-0832.

Respectfully submitted,

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